IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Naren Chaganti, et al.

Ser. Nos. **09/634,725,** **12/799,945,** **13/089,775 and** **13/091,387**	ART UNIT:2132
FILED:	EXAMINER: BENJAMIN LANIER
TITLE:	DOCKET NO: PSCO-007, PSCO-008, PSCO-012 & PSCO-014

PRE-INTERVIEW DISCUSSION POINTS

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Sir:

After giving careful consideration of the pending Office Actions in these related cases, applicants respectfully submit these Pre-Interview Discussion Points to assist the Examiner to prepare for a telephone interview, which is requested but yet to be scheduled. It is pointed out that Applicants' characterization of the cited references is not to be taken as their final and only view of the references, but rather a view developed based on a quick review of the references. Upon closer examination, Applicants may find other features or re-characterize these references differently.

Finality of the First Office Action after an RCE

In Application Ser. No. 09/634,725 & Ser. No. 12/799,945, Applicants filed for an RCE under 37 C.F.R. 1.114, which filing was accepted by the Office. The convention is to grant at least one non-final office action after the filing an RCE. Because the first office action is labeled "final", the Examiner is respectfully requested to withdraw the finality.

Rejections under 35 U.S.C. § 101

The Office Action rejected certain claims in each of the cases as not proper patentable subject matter under § 101, stating that "computer usable medium," "processor readable storage device" and a "computer readable storage medium" were not defined in the specification. Office Action at page 2. Applicants respectfully submit that these are recited in the Specification at page 4, line 7 (disk drive and semiconductor memory); at page 11, lines 20-27 (programming the modules as memory-resident processes). Nevertheless, these claims are amended to overcome the rejections. No new matter is added as a result of the changes. Examiner is respectfully requested to review and enter the amendments.

Claim Amendments

Claim 9 in Ser. No. 12/799,945 inadvertently omitted reciting the term "information object" where the term --digital item-- was recited. This is amended in this response. This amendment does not add any new matter. Examiner is respectfully requested to review and enter the amendment.

In Claim 14 of Ser. No. 12/799,945, there is missing antecedent basis for the term "document", which is amended by striking --the-- before "document" and inserting "a" therefor. In addition, the claim is amended to recite the features of invention more clearly. These changes do not add any new matter. Examiner is respectfully requested to review and enter the amendment.

In Claim 19, of Ser. No. 13/089,775 the Office Action noted that the term "the connection" lacked antecedent basis. This is corrected by deleting --the--. No new matter is added as a result of this deletion. Examiner is respectfully requested to review and enter the amendment.

Examiner's Implicit Official Notice regarding whether "video" information was disclosed in the parent application

Examiner appears to argue that the disclosure of 09/478,796, filed January 7, 2000 had insufficient disclosure of usage of "video" information in the online repository. However, because the term "video" is recited in the Specification, it is believed that Examiner might have taken some form of implicit Official Notice that the disclosure in page 10 did not have sufficient indicia of "video" information objects. But it is respectfully submitted that at Page 10, lines 15-16 the Specification discloses "biometric information (retina scan, samples of speech, finger prints, DNA sequences, and other information)" The term "biometric" includes video information. See, e.g., USP 6,181,803 (Filed 1996) to Davis entitled "Apparatus and method for securely processing biometric information to control access to a node", at Col. 2, lines 26-31 ("video camera used for biometric authentication * * * is continuously capturing * * * data clips (video images) * * * *.") and Col. 4, lines 36-52 (describing video cameras used as biometric information sensing devices). Based on this it is submitted that the term "biometric information" in the Specification is sufficient to disclose the existence of information in a "video" form. Applicants did not limit the term "information" to exclude "video"; in fact, as stated in earlier responses to office actions, the Specification a page 20, line 16 discloses that information comprises "voice, video, data and/.or text or any combinations thereof." Given these illustrations, therefore, Examiner is respectfully requested to point out how the inference that "video" was not disclosed in the Specification, which inference appears to be not grounded in fact and in the nature of an unstated "official notice". Reconsideration is respectfully requested.

The current practice requires an application of a flexible TSM test for prima facie showing of obviousness

In *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007), the Supreme Court stated that courts should use a more flexible approach to determining obviousness, and it rejected a rigid application of the Federal Circuit's "teaching, suggestion, or motivation" (TSM) test. See *KSR*,

550 U.S. at 407 (under this test, a patent claim is only proven obvious if "some motivation or suggestion to combine" known elements can be found). The Court determined that while the "teaching, suggestion, or motivation" test had "captured a helpful insight" into obviousness, it was incompatible with Supreme Court precedent when applied in a rigid and mandatory fashion. *Id.* at 418. The Supreme Court instructed courts to "take account of the inferences and creative steps that a person of ordinary skill in the art would employ" in analyzing the question of obviousness." *Id. KSR* does not completely remove the Examiner's need to demonstrate some reason to combine references, or to show motivation or suggestion or teaching to make the combination. "[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *KSR*, 550 U.S. at 418. The Court said that it is "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." *KSR*, 550 U.S. at 418-19. A reason for the combination is still an important consideration, even though it need not be a rigid formula, nor "a formalistic conception". The Court explained, "[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.") *Id.*, at 418.

In *Ortho- McNeil Pharmaceutical, Inc. v. Mylan Laboratories, Inc.,* 520 F.3d 1358, 1364-65 (Fed. Cir. 2008), the Federal Circuit stated:

> As this court has explained, however, a flexible TSM test remains the primary guarantor against a non-statutory hindsight analysis such as occurred in this case. *In re Translogic Tech., Inc.,* 504 F.3d 1249, 1257 (Fed.Cir.2007) ("[A]s the Supreme Court suggests, a flexible approach to the TSM test prevents hindsight and focuses on evidence before the time of invention."). The TSM test, flexibly applied, merely assures that the obviousness test proceeds on the basis of evidence--teachings, suggestions (a tellingly broad term), or motivations (an equally broad term)--that arise before the time of invention as the statute requires. As *KSR* requires, those teachings, suggestions, or motivations need not always be written references but may be found within the knowledge and creativity of ordinarily skilled artisans. [¶] Otherwise, one may "simply retrace[] the path of the inventor with hindsight, discount[] the number and complexity of the alternatives, and conclud[] that the invention [] was obvious. Of course, this reasoning is always inappropriate for an obviousness test based on the language of Title 35 that requires the analysis to examine "the subject matter as a whole" to ascertain if it "*would have been obvious at the time the invention was made.*" 35 U.S.C. § 103(a) (emphasis added). In retrospect, [applicant's] pathway to the invention, of course, seems to follow the logical steps to produce these properties, but at the time of invention, the inventor's insights, willingness to confront and overcome obstacles, and yes, even serendipity, cannot be discounted." *Ortho-McNeil* at 1364.

Meyer (US Publication 20010031066) does not disclose the step "determining from the license information a number N of times * * *"

As to Ser. No. 09/634,725, Applicants stated that Meyer was not "pertinent" reference not only because the matters for which the Office Action used Meyer as a reference is antedated by the parent application, but also because Meyer does not disclose what the Office Action appears to imply from Meyer. See M.P.E.P. § 2141.02 (stating that a reference must be viewed in its entirety).

To be anticipating, a reference must place the claims of the application 09/634,725 in the public. Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. See M.P.E.P. § 2131; *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed.Cir.1989) ("anticipation" requires that the identical invention is described in a single prior art reference). Meyer does not disclose every element of the independent claims of the '725 application. It appears that the Office Action misinterprets Meyer in such a manner as to read into Meyer what was plainly not disclosed there.

Applicants submit that a mere mention that a "media object" may need a license is insufficient to draw the inference and to characterize Meyer as an anticipatory reference for the claim language.

The Office Action relies on Meyer at [0030], [0057] & [0073] for the proposition that license information may be stored in association with a copyrighted information object, but Meyer does not state thusly. These three paragraphs are reproduced in the following.

> [0030] The server then returns a web page associated with the OID, or re-directs the OID to another server (e.g., one maintained by the content distributor or owner), which in turn, returns a web page of information about the object and links to related actions (e.g., a link to a licensing server, a link to a server for buying and downloading related music etc.). The licensing server may be programmed to download software players and new music offerings compatible with those players. For instance, the licensing server may provide software for decrypting, decoding, and playing electronically distributed music according to usage rules packaged with the electronically distributed music. In this application scenario, the linking of the MP3 file enables the content owner to market music and products that promote the sale of audio objects in other formats, included formats protected with encryption, watermark copy managements schemes, etc.
>
> [0057] The embedding clearinghouse may also offer an identifier embedding services for those wanting to link their media objects with metadata, actions, etc. In this application scenario, the embedding clearinghouse may be implemented as an Internet server that is accessible via a web page using conventional network communication and web protocols. To access the server, users visit a web page using an Internet browser. In exchange for a fee, which may be tendered electronically over the Internet from the user's computer to the server, the server provides an embedding service to embed an identifier into a media object uploaded from the user via the user's computer and Internet connection. The user can select the information to associate with a media object, such as generic identifying information (e.g., title, author, owner), generic

licensing information, or special information or actions. The provider of the embedding clearinghouse server hosts the generic information, while the special purpose information and actions are accessed through re-direction. In particular, the provider of the clearinghouse server links the embedded identifier to an address or set of addresses of servers that provide the special information or actions. Then at decoding time, the decoding process sends the identifier to the provider's server, which in turn, redirects the identifier to a secondary server or servers that provide special purpose information or actions (e.g., redirect to a web page of the content owner, download related content, provide electronic licensing services, etc.).

[0073] establishing a license to use a linked media object

As seen, Meyer at Paragraph [0030] describes that a "licensing server" may "download software players and new music offerings compatible with those players. * * * provide software for decrypting, decoding, and playing electronically distributed music according to usage rules packaged with the electronically distributed music." At Paragraph [0057], Meyer discloses an "embedding clearing house" which offers "an identifier embedding services". Meyer states that this "embedding clearing house" is an "Internet server accessible via a web page using conventional network communication and web protocols" and "provides an embedding service to embed an identifier into a media object uploaded from the user via the user's computer and Internet connection." This information is either "generic identifying information (e.g., title, author, owner), generic licensing information or special information or actions." According to Meyer, "special purpose information or actions" include "redirect to a web page of the content owner, download related content, provide electronic licensing services, etc." And Paragraph [0073] of Meyer states that there could exist a server for "establishing a license to use a linked media object." The differences between the instant claims and the Meyer reference are significant. Hind-sight based reconstruction of claim elements by ignoring claim limitations is not correct. The anticipation rejection appears incorrect. The rejection is believed to be in error because the reference as a whole does not support the reasoning of the examiner. The examiner's assertion of anticipation is inaccurate.

Meyer also uses the word "license" at other locations as follows:

[0014] ("Linked actions include device or programmatic processes for electronically establishing a license, transferring content (either streaming or download), sending an email, recording marketing data about a transaction, etc. The identifier allows a fan of a particular type of music or artist to get more information about the music and to buy more music. From the perspective of the artists and record labels, the identifier provides an additional opportunity to promote their music and sell content, concert tickets, etc.");

[0061] ("The decoder may collect identifiers in response to a user request while objects containing these identifiers are being played. For example, when the user is playing music, he may like a song and want to buy it or get more information. This feature may be implemented by building an interface that has a

button or voice recognition that enables the user to request information or a buy/license opportunity. Once captured, identifiers can be forwarded along with user instructions to the appropriate server.")

[0069] ("As discussed elsewhere, the servers used to link identifiers to actions may be programmed to provide a variety of actions including: * * *")

This disclosure is insufficiently enabled to render the claim element invalid. For example, how the server used to link identifiers to actions are programmed to provide the action of "establishing a license to use a linked media object" is not enabled or made clear. A reference must be enabled for the purpose it is used as a reference before it is proper reference to invalidate a claim element. Reconsideration is respectfully requested.

Meyer is vague, ambiguous and uncertain and further does not disclose the things for which the Office Action relies.

As to claim 14 of Ser. No. 12/799,945, the Office Action states that Meyer discloses that an online repository may receive an information object from a second server computer. In support, the Office Action cites Meyer at [0093]-[0095], which paragraphs are reproduced here:

[0093] In this application, a local application (e.g., a device or software process) extracts an identifier from a media signal stored in a content package, and communicates the identifier to a database application to create and manage a library of media titles. Examples of a content package include optical media such as CDs and DVDs, magnetic media such as floppy disks and tapes, flash memory, compressed media files, etc. The user places the package into a media reader, such as a disk drive, player, etc. Operating in conjunction with the media reader, the local application extracts information (e.g., a portion of the media signal) from the package, extracts the identifier, and sends it to a database system (e.g., a server on the Internet). In response, the database system determines the corresponding title and adds the title to an on-line library (e.g., external storage accessible via the Internet). The library may be set up as a personal collection, or a collection for a group of users.

[0094] To identify the user(s)' library, the local application provides a user identifier. This user identifier may be authentication information entered by a user (such as a user name and password), or alternatively, may be an identifier (such a device ID) sent automatically by the local application.

[0095] The title (i.e. content) is added to the on-line library, by transferring a copy of the selection (e.g., music track, video, etc.) from a master database (e.g., a library of MP3 files, or some other streaming or downloadable content format) to the user's on-line library collection. This arrangement avoids the need to upload content from the user's application. Also, it is a much more secure approach than techniques that simply read title data from a CD and relay same to the on-line library. (It is a simple task for an unscrupulous user to fake the

> presence of a CD by determining how the client CD software specifies the title to the on-line library, and then mimic same even without possession of a bona fide CD.) The in-band encoding presented by watermarks offers innately better security, and provides opportunities for enhanced security by encryption, etc.

At Paragraph [0093], Meyer discusses a "local application" but Meyer did not state to what this application is "local," making the disclosure non-enabling and thus inadequate. See *Application of Turlay*, 304 F.2d 893, 899 (C.C.P.A. 1962)("In order to anticipate, the teaching of a reference must be clear and unambiguous."). Proceeding further, Meyer states that this "local application" does the following: "Operating in conjunction with the media reader, the local application extracts information (e.g., a portion of the media signal) from the package, extracts the identifier, and sends it to a database system (e.g., a server on the Internet). In response, the database system determines the corresponding title and adds the title to an on-line library (e.g., external storage accessible via the Internet)."

Note that Meyer appears to use the term "identifier" differently from an "audio signal." See Paragraph [0012] ("As described further below, an identifier attached to an audio signal is used to connect that signal with metadata and/or programmatic or device actions. In the context of this document, the terms "media object" and "audio object" refer to an electronic form of a media signal and audio signal, respectively.") Thus, an "audio signal" itself is not an identifier; rather the identifier is attached to an audio signal. Based on this description, it appears that Meyer's usage of the term "identifier" is not consistent with what is understood by the Examiner's usage of the term "content." Further, at Paragraph [0018], Meyer states: "In some application scenarios, the embedding process interacts with a registration process to get an identifier. The embedding process provides information about the object (e.g., a title and artist name, an ISRC, name of distributor, etc.)" Based on this description, it appears that "title" is "information about" an "object" rather than the object itself. Accordingly, the word "title" in Meyer appears not to connote the same meaning as the Examiner's usage of the term "content." There is authority for the proposition that prior art publications must be taken for what the author said, not for what one may think he meant to say. See, e.g., *Badische Anilin & Soda Fabrik v. Kalle & Co.*, 104 F. 802 (2d Cir. 1900), where the Court stated:

> " * * * The 'description in a printed publication' of the statute is to be found within the four corners of such printed publication. * * * The question is, what does not prior publication say? not what it might have said, or what it should have said. If prior patents and publications can be reconstructed by extrinsic evidence to fit the exigencies of the case, the inquiry will no longer be confined to what the publication communicates to the public, but it will be transferred to an endeavor to ascertain what its author intended to communicate."

BASF, at 808 (citation and quotation omitted).

At Paragraph [0093], Meyer states that the "local application" "sends" "the identifier" of a media signal to a server on the Internet. "In response, the database system determines the corresponding title and adds the title to an on-line library (e.g., external storage accessible via the Internet). The library may be set up as a personal collection, or a collection for a group of users." How "the database system determines the corresponding title" and how the database system

"adds the title to the on-line library" is not described.

At Paragraph [0094] Meyer states that "to identify the user(s)' library, the local application provides a user identifier." But the disclosure is silent as to the recipient of "this user identifer". Meyer also states that "[t]he title (i.e. content) is added to the on-line library, by transferring a copy of the selection (e.g., music track, video, etc.) from a master database (e.g., a library of MP3 files, or some other streaming or downloadable content format) to the user's on-line library collection." Note that Myer is silent about how the master database receives information about "the user's on-line library collection" or about the need to transfer "the title (i.e. content)" to that user's "on-line library collection."

At Paragraph [0095] Meyer states, "The title (i.e. content) is added to the on-line library, by transferring a copy of the selection (e.g., music track, video, etc.) from a master database (e.g., a library of MP3 files, or some other streaming or downloadable content format) to the user's on-line library collection." Thus, Meyer uses the word "content" to mean "title" which was defined as "information abou the object" and not the "object" itself. Otherwise, Meyer by equating the term "title" with "content," Meyer introduced self-contradiction with the statment in Paragraph [0018] that "title" is "information about the object". To add to the confusion, Meyer variously uses the terms "media object", "broadcast object", "object", "objects transmitted over networks" etc. without clearly describing the relationship among these several types of objects. Because one may not use an uncertain, incomplete or unenabled disclosure as a proper reference under § 102, these identified infirmities remove Meyer as a proper reference. See *In re Cramblet*, 62 F.2d 358, 362 (C.C.P.A. 1932), where the Court stated:

> [Applicant] therefore argues that, while it might by some construction be contended that such cup was out of contact with the wall, the language [of the reference] does not necessarily so state, and, inasmuch as it may be thus capable of a double meaning, or construction, his disclosure should not be held to be anticipated by such vague and indefinite language.
>
> We are of opinion the point thus made by the appellant is well taken. If it could be plainly discerned from an inspection of Mailey's drawings and a reading of his claims, together with his specification, that he had this particular idea of appellant's in mind, even though it were not claimed, we might fairly agree that appellant's claims here were properly rejected. But, when there is every reason to believe from his disclosure that Mailey had no conception of a cup entirely segregated from the switch envelope, it is, in our judgment, improper to reject appellant's clearly defined and limited claims, resting upon his definite disclosure of this feature.
>
> This we believe has been the prevailing view of the courts when similar questions arose. 'Statements in a prior application relied on to prove anticipation must be so clear and explicit that those skilled in the art will have no difficulty in ascertaining their meaning. Where they are so vague, involved, intricate and contradictory that experts disagree radically as to their meaning and, following the instructions given, construct devices differing in fundamental features, it is safe to reject such a document as an anticipation.'"

See also, *Tilghman v. Proctor*, 102 U.S. 707, 711-712 (1881)(If the acids were

accidentally and unwittingly produced, whilst the operators were in pursuit of other and different results, without exciting attention and without its even being known what was done or how it had been done, it would be absurd to say that this was an anticipation of Tilghman's discovery."); *Cimiotti Unhairing Co. v. Comstock Unhairing Co.*, 115 F. 524 (C.C. 1902) ("A document so obscure in its terminology that two conflicting theories may be deduced therefrom and supported by equally plausible arguments is too indefinite to be utilized as an anticipation.").

In addition to these inadequacies of Meyer, Meyer does not disclose the feature "receiving" a request to add a particular document to a first user's online library established on a first server computer, viewing the claim as a whole, Meyer cannot anticipate the invention as claimed in claim 14. Examiner is respectfully requested to review and reconsider.

Finally, Claim 14 inadvertently had errors related to antecedent basis, for example, the term "the document" should have been recited as "a document". In addition, minor changes are made to Claim 14 to clarify the features of the invention. These changes do not add any new matter. Examiner is respectfully requested to review and enter the amendment.

Atkinson reference

Relying on *In re Oetiker*, 977 F.2d 1443, (Fed Cir. 1992), the Office Action states that Atkinson is pertinent reference to or person of ordinary skill in the art facing the problem of "use of expirations for content licenses." Office Action at page 3, Paragraph 7. However, *Oetiker* says more than what is quoted in the Office Action. In *Oetiker*, the examiner looked to fasteners for garments in order to solve the problem of fastening a hose clamp. Reversing the Examiner's rejection, the Federal Circuit stated:

> In order to rely on a reference as a basis for rejection of the applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. See *In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed.Cir.1986). Patent examination is necessarily conducted by hindsight, with complete knowledge of the applicant's invention, and the courts have recognized the subjective aspects of determining whether an inventor would reasonably be motivated to go to the field in which the examiner found the reference, in order to solve the problem confronting the inventor. We have reminded ourselves and the PTO that it is necessary to consider "the reality of the circumstances", *In re Wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979)--in other words, common sense--in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.
>
> It has not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments. The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the

combination. That knowledge can not come from the applicant's invention itself.

Id at 1447. In the present case, Examiner states that the problem of restricting licenses is the reason one would have lookd to Atkinson. But that is hindsight reasoning because Atkinson is not about restricting licenses. Atkinson is about embedding certification of an executable file in order to ensure its authenticity. See Paragraphs [0010] & [0011], summarizing Atkinson:

> [00010] A certification or signing method ensures the authenticity and integrity of a computer program, an executable file, or code received over a computer network. The method is used by a publisher or distributor to "sign" an executable file so it can be transmitted with confidence to a recipient over an open network like the Internet. The executable file may be of any executable form, including an executable or portable executable .exe file format, a .cab cabinet file format, an .ocx object control format, or a Java class file.
>
> [00011] The code signing method assures the recipient of the identity of the publisher as the source of file (i.e., its authenticity) and that the file has not been modified after being transmitted by the publisher (i.e., the integrity of the file). As a result, the code signing method allows an executable file to be transmitted over open computer networks like the Internet with increased certainty in the identity of the source of the file and minimized risk of contracting a computer virus or other malicious executable computer files.

Based on this, it appears to be an error to characterize Atkinson as a source for a person of skill in the art to look for solution for the problem of "use of expirations for content licenses". See *In re Deminski*, 796 F.2d 436, 443 (Fed.Cir. 1986)("The only way the board could have arrived at its conclusion was through hindsight analysis by reading into the art [applicant's] own teachings. Hindsight analysis is clearly improper, since the statutory test is whether "the subject matter as a whole would have been obvious at the time the invention was made.'")(citation omitted). Applicants submit that Examiner has the initial burden of showing obviousness before shifting the burden to the Applicants to show evidence of nonobviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Reconsideration is respectfully requested.

Glassman teaches away from an implementation in an open network for N-user licenses

The Office Action asserts that Applicants did not show why Glassman taught away from the combination of Glassman with other references as combined in the Office Action.
Applicants submit that Glassman (USP 6,453,305) teaches away from the type of license such as the one claimed in the instant application. Glassman states:

> There are many existing implementations of lock servers. However, they all are subject to one or more of the following undesirable restrictions:
>
> each content source has its own, separate, and proprietary lock server;
>
> the user's system already has the content protected from direct access and the client program gets the lock to access the content;
>
> acquiring a lock is a complicated action; and/or
>
> the set of valid users is limited.
>
> For these reasons, existing lock servers are undesirable on an open network.

> A lock server providing an N-user license on an open network should also support the following requirements:
>
> an unrestricted set of potential users; no single administrative domain covers all users;
>
> the users do not need to have a separate user application for each source of content;
>
> access to the content can be easily restricted; and
>
> the content exists on the server and not with the user.
>
> Accordingly, there is a need for a way to provide restricted access to electronic content that works with a wide variety of possible access schemes. Preferably, the solution will allow enforcement of an N-user license for content located on an open network like the Internet.

See Col. 2, lines 2-31. Upon so criticizing and declaring the inadequacy of methods used in other areas such as a library or a corporation using a CD-ROM to distribute licensed copy of an electronic version of a magazine, Glassman set out to invent a new method

> "for electronic commerce that uses special scrip —called "license scrip"—to provide temporary licenses to consumers accessing content. Scrip is primarily used as a form of electronic currency, however it can be more generally considered as a one-time token representing a general value. When scrip is used as an electronic currency, its value is monetary. When scrip is used as a temporary license, its value is the permission to access specific content. This permission may be unlimited or it may be for only a relatively brief period of time, say a few minutes to a few hours."

See Summary of the Invention, first paragraph. Glassman thus discarded other possible solutions for the reasons given in the disclosure, namely, because an open network such as the Internet was unlike a corporate network because the Internet may have an unrestricted set of potential users, and in an Internet-based system the content exists on the server and not with the user, etc. and conceived the concept of a "scrip" or a "token" to "enforce[] a license agreement for content on an open network by restricting the number of consumers that can concurrently access the content." See Abstract, first sentence.

In *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007) the Supreme Court stated, "[W]hen the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious." A reference that "criticize[s], discredit[s], or otherwise discourage[s] the solution claimed", teaches away from the combination. *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004). Based on Glassman's criticism of other known methods, one of ordinary skill in the art, given Glassman reference, would not have taken the path taken by the Applicants. See *Ecolochem, Inc. v. Southern Cal. Edison Co.* 227 f.3d 1361, 1375 (Fed. Cir. 2000)("The evidence available, however, indicates that if one of ordinary skill in the art had been given the Houghton reference, they would not have been inclined to use it, due to the large amount of teaching away.") See also, *In re Gurley*, 27 F.3d 551, 553 (Fed.Cir.1994)("A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant."); *United States v. Adams*, 383 U.S. 39, 52 (1966) ("known disadvantages in old devices which would naturally discourage the search for new inventions may be taken into

account in determining obviousness"); *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1550-51(Fed.Cir.1983) (the totality of a reference's teachings must be considered), cert. denied, 469 U.S. 851 (1984); *In re Sponnoble*, 405 F.2d 578, 587 (CCPA 1969) (references taken in combination teach away since they would produce a "seemingly inoperative device"); *In re Caldwell*, 319 F.2d 254, 256 (CCPA1963) (reference teaches away if it leaves the impression that the product would not have the property sought by the applicant). References that teach away from a claim cannot be used to establish obviousness of the claim with respect to that element.

In order to make a showing of obviousness based on the combination of Manolis or Meyer with Glassman, the Office has the initial burden of showing why one of ordinary skill in the art would, given Manolis or Meyer reference, look to Glassman to arrive at the instant claims, especially in view that Glassman teaches away from using the methods he reviewed as not useful for an open network such as the Internet. Moreover, Glassman does not enable the methods either. For example, Glassman does not enable the so-called "existing implentations of lock servers". One need to speculate the features of these "lock servers" and thereafter further speculate the method of making such "lock servers", and later speculate that a person of skill in the art would have been able to use the "lock servers" in precisely the type of "open network" that Glassman says they would not work.

Though Glassman discusses making available of a copyrighted magazine by a library, corporation or other organization may restrict content (i.e., the magazine is either in a paper copy or an electronic version stored on a CD-ROM) using an N-user license, Glassman does not describe the implementation of such a method. In addition, Glassman does not give enabling details of the "combination of a specialized lock server and a client program." Glassman believed that because each "content source" required its own "separate proprietary lock server," which required Glassman to invent a different mechanism "to provide restricted access to electronic content that works with a variety of possible access schemes." Noting that all existing systems were insufficient to deliver licensed "content located on an open network like the Internet" for certain reasons. Under these circumstances, it is not correct to argue that one of ordinary skill in the art would have used Glassman as a reference for the very methods that Glassman found unsuitable. Therefore it is submitted that Glassman teaches away from the combination as suggested by the Office Action.

Though not relevant here, Applicants note that Glassman believed that because each "content source" required its own "separate proprietary lock server," which required Glassman to invent a different mechanism "to provide restricted access to electronic content that works with a variety of possible access schemes." The claims under examination present a simple and effective solution wherein each information object is restricted as to the number of users via a locking mechanism executed in the manner described in the application. Cautioning that sometimes simple inventions may be of great benefit, the Supreme Court stated,

> "[An invention's] simplicity should not blind us as to its character. Many things, and the patent law abounds in illustrations, seem obvious after they have been done, and, "in the light of the accomplished result," it is often a matter of wonder how they so long "eluded the search of the discoverer and set at defiance the speculations of inventive genius." *Pearl v. Ocean Mills*, 11 Off. Gaz. 2. Knowledge after the event is always easy, and problems once solved present no difficulties, indeed, may be represented as never having had any, and expert

> witnesses may be brought forward to show that the new thing which seemed to have eluded the search of the world was always ready at hand and easy to be seen by a merely skillful attention. But the law has other tests of the invention than subtle conjectures of what might have been seen and yet was not. It regards a change as evidence of novelty, the acceptance and utility of change as a further evidence, even as demonstration. And it recognizes degrees of change, dividing inventions into primary and secondary, and as they are, one or the other, gives a proportionate dominion to its patent grant. In other words, the invention may be broadly new, subjecting all that comes after it to tribute (*Railway Co. v. Sayles*, 97 U.S. 554, 556); it may be the successor, in a sense, of all that went before, a step only in the march of improvement, and limited, therefore, to its precise form and elements, as the patent in suit is conceded to be. In its narrow and humble form it may not excite our wonder as may the broader or pretentious form, but it has as firm a right to protection. Nor does it detract from its merit that it is the result of experiment, and not the instant and perfect product of inventive power. A patentee may be baldly empirical, seeing nothing beyond his experiments and the result; yet if he has added a new and valuable article to the world's utilities he is entitled to the rank and protection of an inventor. And how can it take from his merit that he may not know all of the forces which he has brought into operation? It is certainly not necessary that he understand or be able to state the scientific principles underlying his invention, and it is immaterial whether he can stand a successful examination as to the speculative ideas involved.

Diamond Rubber Co. of New York v. Consolidated Rubber Co., 220 U.S. 428, 434-436 (1911). "The fact that the invention seems simple after it is made does not determine the question; if this were the rule, many of the most beneficial patents would be stricken down." *Expanded Metals v. Bradford*, 214 U.S. 366, 381 (1909). "The quality of non-obviousness is not easy to measure, particularly when challenged years after the invention was made. That which may be made clear and thus 'obvious' to a court, with the invention fully diagrammed… may have been a breakthrough of substantial dimension when first unveiled." *Interconnect Planning Corp., v. Thomas E. Feil,* 774 F.2d 1132, 1139 (Fed. Cir. 1985). "It is impermissible to first ascertain factually what [the applicant] did and then view the prior art in such a manner as to select from the random facts of that art only those which may be modified and then utilized to reconstruct [the applicants'] invention from such prior art." *Id.* at 1141.

Manolis does not enable the features for which Manolis is used as reference

As to Ser. No. 09/634,725, the office action acknowledges that Manolis does not disclose the claim element of including in an online repository copyrighted information object as claimed. Thereafter, the Office Action makes conclusory assertion that one of skill in the art would have looked to Glassman to fill in the remaining steps. A finding of "obviousness requires that the claimed invention as a whole would have been obvious" (see 35 U.S.C. § 103; *CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003)) and "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). For Manolis is about online printing service, and Glassman expressly disregards the usage of certain licensing systems for an "open" network such as the Internet. See *KSR Int'l Co. v. Teleflex, Inc.*,

550 U.S. 398, 421 (2007)("A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning. See *Graham*, 383 U. S., at 36 (warning against a .temptation to read into the prior art the teachings of the invention in issue. and instructing courts to . .guard against slipping into the use of hindsight. . (quoting *Monroe Auto Equipment Co.* v. *Heckethorn Mfg. & Supply Co.*, 332 F. 2d 406, 412 (CA6 1964))).")

The combination of Manolis and Glassman would not have been obvious to one of skill in the art

In *Ex Parte Val Mandrusou*, Application Serial No. 10/235,221, 2008 WL 2845083 (B.P.A.I. 2008), the Board stated:

> The Examiner's articulated reasoning . . . in the rejection must possess a rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). The Supreme Court, reiterating this reasoning by citing *In re Kahn*, 441 F.3d at 988, stating that 'rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.' *KSR* at 1741.
>
> "The combination of elements from nonanalogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness." *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992). Because Manolis is an online print service, and Glassman is directed toward a license scrip for permitting access to copyrighted material, the Examiner bears the initial burden of showing the reason for making a combination. Rejections based on 35 U.S.C. § 103 must rest on a factual basis. "Examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis." See *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967).

As to Ser. No. 12/799,945, the office action states that Manolis could be used as a 102(e) reference for claim 2. But a reference under 35 U.S.C. § 102 or 103 must be enabled. See *Elan Pharms., Inc. v Mayo Found.*, 346 F.3d 1051, 1054 (Fed. Cir. 2003) ("Enablement requires that 'the prior art reference must teach one of ordinary skill in the art to make or carry out the claimed invention without undue experimentation.'" (quoting *Minn. Mining and Mfg Co v. Chemque, Inc.*, 303 F.3d 1294, 1301 (Fed. Cir. 2002))); *In re Donahue*, 766 F.2d 531, 533 (Fed. Cir. 1985) (stating that prior art references must be enabling).

Manolis does not enable how the "host system"sets access permissions to enable the intended recipient to access online images specified by the user

In addition, a person of skill in the art would not have known how to make the invention as recited in Claim 2. At pertinent part, Manolis states as follows:

> As shown in FIGS. 24 and 25, a user optionally can share his/her online photos (i.e., those images that the user has uploaded to the host computer system) with other users (e.g., friends, family, colleagues, etc.) in order to make a

personalized collection of photos available to each of the other users. To do so, the user accesses the Share Photos page 2400 and addresses the Unaddressed envelope 2401 in the manner described above. The Share Photos envelope 2401 differs, however, from the envelopes presented in the My Photos page. Specifically, the Share Photos envelope 2401 does not hold images that are to be printed and delivered to one or more recipients; rather, the Share Photos envelope 2401 hold images that are to be made accessible online to the specified share recipient. That recipient, however, can then order prints of the shared images if desired.

After addressing the Share Photos envelope 2401, the user optionally can specify a subject line 2402 and/or a message 2403 that will be sent in an automatically generated e-mail message (not shown) to the intended share recipient, along with information (URL, Sign In name, password, etc.) for accessing the shared images. The user completes the photo-sharing sequence by clicking the Share Now button 2404, which results in the above-noted photo-sharing e-mail message to be generated and sent, and causes the host system to set access permissions as appropriate to allow the intended share recipient to access the online images specified by the user. The host system confirms successful completion of the photo-sharing sequence by displaying a Share Confirmed pop-up window 2600, as shown in FIG. 26.

The user can view online photos that others have shared with him/her by accessing the Friends' Photos page 2700 shown in FIG. 27. The Friends' Photos page 2700 includes various items of information to identify the friend 2702 who shared these images, along with the Subject 2703 and Message 2704 specified by that friend. The functionality provided by the Friends' Photos page 2700 essentially is the same as the My Photos page. That is, the Friends' Photos page 2700 enables the user to select images and order copies of them for one or more recipients, each having a separate envelope, in the manners described above.

If more than one friend has shared photos with the user, the user can switch between different Friends' Photos pages by clicking the VIEW Other Friends' Photos link 2701, which brings up the Select Friends' Photos window 2800 shown in FIG. 28. In this example, two different friends 2801 and 2802 have shared photos with this user. If the user clicks on the link 2801, a different friend's photos are displayed in another Friends' Photos page 2900, as shown in FIG. 29.

See Col. 9, line 35-Col. 10, line 18. Manolis uses the term "access permissions" and without any further detail as to how the "host system" sets access permissions or how such permisions would enable an intended recipient to access the online images specified by the user. Manolis fails to describe how the host system determines what was "appropriate" for the intended recipient. Given Manolis, a person of skill in the art of online print service would not have invented an online personal library to store information objects containing voice, video, data and/or text for a plurality of users in the manner recited in claim 2.

Manolis does not enable the drag-and-drop feature

Manolis (USP 7,243,079) does not enable the "drag and drop" feature for which it was used as a reference. The relevant description in Manolis is as follows:

> FIG. 9 shows a single image upload page 90 that enables users to upload images, for example, from the user's client computer to the online print service's host computer system. The user designates an image for uploading by entering the image file name (e.g., including a complete filename path such as "c:\images\PIC0001.jpg") into the text field 91, and then clicking the Upload button 92. Optionally, the user can download a plugin--a piece of executable code that, when installed, modifies the browser's operation, for example, to allow the browser to manage non-native date types or to provide enhanced functionality--by clicking the Get Plugin button 93. The plugin in this example is a download plugin that enhances the browser's functionality to support drag-and-drop uploading of multiple images.
>
> FIG. 10 shows the Upload page 1000 as it appears to the user after downloading and installing the download plugin. As shown, this Upload page 1000 includes a drop spot 1002 onto which a user can drag-and-drop one or more image files to designate them for uploading.
>
> FIG. 11 shows the Upload page 1000 as it appears after the user has dragged-and-dropped image files onto the drop spot 1002. As shown, the plugin automatically creates and displays an image thumbnail 1003 for each of the image files dropped onto the drop spot 1002. In this implementation, up to eight thumbnails are displayed on a single page. If the user has uploaded more than eight images, the user can view and/or access the corresponding thumbnails not currently visible by clicking a scrolling control indicated by a downward arrow 1006 or an upward arrow (not shown).

See Col. 5, line 60-Col. 6, line 11. Manolis "plugin" is not described sufficiently to enable a person of ordinary skill in the art to make the feature. Manolis states that the "plugin" "automatically creates and displays an image thumbnail for each of the image files dropped onto the drop spot 1002", but fails to describe the software required to perform this function, which makes this description of a "plugin" insufficient to teach a person of skill in the art to make the software program. Manolis generally states that the "plugin" is a piece of software code, but did not describe how a drag-and-drop operation may be implemented via a plugin or how a "thumbnail" is created or displayed "for each of the image files dropped onto the drop spot". Any enablement must be shown based on the technology and/or practices known or available at the time Manolis described the features of the "plugin" program. It is wel understood that any cited prior art must enable the feature for which it is cited as prior art, and such enablement must satisfy the requirement that one of ordinary skill in the art should not have to engage in undue experimentation to make the feature.

Phillips is antedated by the effective filing date of the application under examination

Application Ser. No. 12/799,645 has an effective filing date of at least August 5, 2000. Therefore, Phillips (USP 7,058,696) being filed on November 1, 2000 cannot be valid reference to reject the claims under examination. Applicants note that Phillips claims benefit of a

provisional application 60/163,008 filed on November 11, 1999, but this filing does not disclose the material for which the Office Action relies on Phillips. Therefore, based on the filing date of November 1, 2000 for Phillips, claims 15-16, 18, 20 & 22, cannot be rejected as unpatentable over Phillips under 35 U.S.C. § 102(e). Likewise, Claims 17, 21 and 23, which are rejected as being unpatentable over a combination of references under 35 U.S.C. § 103, in which combination of references Phillips is the primary reference, are also believed to be patentable. Moreover, because independent claims are believed to be patentable, the dependent claims are also believed to be patentable.

In addition, the references which are used in combination with Phillips, namely, Chen, Watson etc are not believed to be pertinent to the field of endeavor in this case. Chen, as argued in prior responses to office actions, is about scanning for viruses attached to an e-mail message by detaching an attachment to an e-mail message, scanning the attachment for viruses, and reattaching the attachment to the e-mail message.

Likewise, Watson discloses a method of providing personal computer security and is not pertinent reference because one of ordinary skill in the art is not shown to have any reason to refer to Watson for the idea of creating an audit trail or log while designing an online document collaboration system such as the one claimed in the rejected claim 17.

Therefore Chen and Watson are believed to be not correct references. Reconsideration is respectfully requested.

Watson is not a correct reference for the argument that an audit trail inherently disclosed recording the identity of a user

Watson (USP 5,475,839) is combined with the primary reference Phillips to argue that claim 21 would have been obvious over the combination of the references. However, as argued above, Phillips is antedated by the instant applications. Moreover, Watson is directed to controlling acces to a personal computer in a networked environment. See Fig. 4 (showing that the host protects a personal computer from viruses before permitting the personal computer to be used as a work station in a networked environment.) This being not analogous to the claims under examination which are directed toward a document collaboration system, it is respectfully submitted that one of skill in the art, given Phillips as a primary reference, would not be facing a problem for which the person would be looking to Watson for answers. See *In re Wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979)("The determination that a reference is from a nonanalogous art is therefore two-fold. First, we decide if the reference is within the field of the inventor's endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved.") Under the Graham factors, the Examiner bears the initial burden of proving that the reference is from analogous art.

As regards claim 21, Examiner also argues that "storing the identity information is inherent to any reference that discloses access logs/audit trails". In an inherency rejection, Examiner has the burden of establishing the prima facie case of anticipation by producing evidence that the allegedly inherent characteristics necessarily are present from the teaching of the cited art. See M.P.E.P. § 2112; *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (B.P.A.I. 1990). "The mere fact that a certain thing may result from a given set of circumstances is not sufficient." See M.P.E.P. § 2112; *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). Inherency must be "the natural result flowing from the operation as taught", and must be ***inevitable*** result of the description given in the cited art. See *In re Oelrich*, 666 F.2d 578,

581-82 (Fed. Cir. 1993). Inherency may not "be established by probabilities or possibilities." *Id.*, at 581, and inherency may not be the result of "optimization of conditions". See *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art). Examiner's statement therefore appears be erroneous. Further, "a retrospective view of inherency is not a substitute for some teaching or suggestion which supports the selection and use of the various elements in the particular claimed combination. *In re Newell*, 891 F.2d 899, 901 (Fed. Cir. 1989) (citing Smithkline Diagnostics v. Helena Laboratories Corp., 859 F.2d 878, 886-87 (Fed.Cir.1988)). "That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown." *Id.*, (citing *In re Spormann*, 363 F.2d 444, 448, 53 CCPA 1375, 1380 (1966)). Examiner is respectfully requested to reconsider. Moreover, in view that the independent claim from which this claim depends is found patentable, a separate unobviousness discussion regarding this claim may be moot. See *In re Fritch,* 972 F.2d 1260, 1266 (Fed.Cir.1992) ("[D]ependent claims are nonobvious if the independent claims from which they depend are nonobvious.").

The "Obvious-to-Try" rationale in making combinations

Examiner appears to have combined two references, Shea (directed toward an exercise apparatus) and Jerger (directed toward a client device which uses a "method of providing security when downloading foreign active content from a computer network.") with the primary reference Manolis based on an "obvious to try" rationale. But it is impermissible to invalidate a claim under an "obvious to try" rationale where what was "obvious to try" was either (1) "to vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful" or (2) "to explore a new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it." *Application of Kubin*, 561 F.3d 1351, 1359 (Fed. Cir. 2009).

In rejecting a claim, the PTO may not use the claim as a template in order to fill in the gaps with hindsight reconstruction. Because hindsight reasoning creates prejudice against a valid invention, the Supreme Court instructed courts (and Examiners) to 'guard against slipping into use of hindsight', and to resist the temptation to read into the prior art the teachings of the invention in issue. in *Graham v. John Deere Co.*, 383 U.S. 1, 36 (1966). Recently the Supreme Court reiterated this caution to fact finders against "the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning." *KSR*, at 1742.

Obviousness under 35 U.S.C. § 103(a) is ultimately a legal question, based on underlying factual determinations. See *Richardson-Vicks, Inc. v. Upjohn Co.*, 122 F.3d 1476, 1479 (Fed. Cir. 1997). The factual determinations underpinning the legal conclusion of obviousness include 1) the scope and content of the prior art, 2) the level of ordinary skill in the art, 3) the differences between the claimed invention and the prior art, and 4) evidence of secondary factors, also known as objective indicia of non-obviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). Examiner being a fact finder, should set forth facts supporting application of the *Graham* factors. See M.P.E.P. § 2141.

Jerger cannot be combined with Manolis because they are from different areas of endeavor

Jerger (USP 6,321,334) is cited for the proposition that an applet or a JavaScript program is known in the art. However, Jerger is directed toward a client device which uses a "method of providing security when downloading foreign active content from a computer network." See Summary of the Invention. See Col. 10, lines 43-48 ("As used herein, active content is defined as any computer-executable instructions that are downloaded (retrieved) from a server computer and that can run on a user's (or host) computer. Examples of active content are Java applets, Java classes, HTML scripts, Java scripts, VB scripts and ActiveX controls.")

Jerger states that it is directed toward a method of "configuring a system security policy to establish multiple security zones, each security zone corresponding to a set of locations on a computer network. Each zone has a corresponding security configuration that specifies the actions to be taken when a protected operation is requested by active content downloaded from that security zone." See Summary of the Invention, Col. 3, lines 9-13.

A method of providing security to a client device while downloading "foreign active content" cannot be equated with an online repository. Moreover, contrary to the implication in the Office Action, Jerger did not state that JavaScript programming is one of the few finite ways of programming the features of the rejected claim. Therefore it is submitted that the Office Action did not meet its initial evidentiary burden that one of ordinary skill in the art would, given Manolis, have looked to Jerger for the features of the rejected claim appears to be an error.

Shea is not in an analogous art to an invention about online information repository

The Office Action cited Shea (USP 6,042,519) as a secondary reference that could be combined with Manolis to render obvious the rejected claims. However, Shea is directed toward an exercise machine and is neither an art analogous to the rejected claim, nor is it a source that one would refer to in order to invent "out-of-band" communication channel as claimed in the instant application. Shea states "For example, data may be broadcast to the exercise apparatus via an in-band or out-of-band data channel of a conventional cable television system." Shea applied an out-of-band data channel of a "conventional cable television system" to an exercise machine apparatus. Nothing in Shea or other references of record suggests using an "out-of-band" channel for communicating between a client computer and a server computer via a data communication network such as the Internet. Moreover, nothing in the cited art suggests using an "out-of-band" channel for communication between a browser-controlled window and a server computer.

Though the Office Action states that it using an out-of-band connection was one of the finite methods of establishing a connection with a server computer, it still remains unexplained as to what "recognized problem" at the time of the invention date, would have been solved by the disclosure of Shea in order to render the rejected claim obvious. The Office Action shows no problem (faced by a person of skill in the art) that would have required one to seek a solution to use the "out-of-band" communication method in order to solve the problem. Examiner is requested to show why one would be looking to Shea without the benefit of the instant claimed invention as a blueprint. See *Loom v. Higgins,* 105 U.S. 580, 591 (1882) ("Now that [the

invention] has succeeded, it may seem very plain to any one that he could have done it as well. This is often the case with inventions of the greatest merit.")

Combining Shea with other references in this case appears to be hindsight based reasoning using the instant claims as a basis, which is not right. It appears that the teachings of the application formed the very basis for this combination to reconstruct each term in a claim to be rejected by searching for a reference that uses that word or phrase.

Reconsideration is respectfully requested.

Weinreich is an inapposite reference and is in applicable to storing a user's preferences in an online repository

As to Ser. No. 13/091,387, the Office Action cites Weinreich (USP 6175831) for the proposition that the step of "storing a user's preferences to a product or service" were anticipated. "Anticipation of a patent claim requires a finding that the claim at issue 'reads on' a prior art reference." *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed Cir. 1999) ("In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.") To anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim. *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed. Cir. 2001). "[A]bsence from the reference of any claimed element negates anticipation." *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571 (Fed. Cir. 1986). Further, an anticipating reference "must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed in the prior art and that such existence would be recognized by persons of ordinary skill in the field of the invention." *Crown Operations Int'l, Ltd. v. Solutia Inc.*, 289 F.3d 1367, 1375 (Fed. Cir. 2002) (citations omitted).

Weinreich (USP 6175831) describes

> "A networking database containing a plurality of records for different individuals in which individuals are connected to one another in the database by defined relationships. Each individual has the opportunity to define the relationship which may be confirmed or denied. E-mail messaging and interactive communication between individuals and a database service provider provide a method of constructing the database. The method includes having a registered individual identify further individuals and define therewith a relationship. The further individuals then, in turn, establish their own defined relationships with still other individuals. The defined relationships are mutually defined."

See Abstract. The type of information stored in Weinreich is described at Col. 18, lines 3-9, Weinreich discloses:

> When a user registers with DSP 12 and becomes a member, the user may list various personal and professional information including e-mail address(es), last name, first name, aliases, occupation, geography, hobbies, skills or expertise, and the like. Certain user provided information, such as name, address, phone numbers, etc., may be consolidated in a "white pages" record of database 70.

From these excerpts, it is readily seen that Weinreich does not describe storing a user's preference (to a product or service), which is recited in the rejected independent claims. The

Office Action states that Weinreich describes that users enter their "personal and professional information through a browser interface to fill out their personal profile." Based on this, the Office Action states that the step "sending a message to the online repository indicating the user's preference" was anticipated. It is clear that "personal and professional information" as used in Weinreich is not the same as indicating a person's preference, for example, to a product or service.

Weinreich is not used to store a user's personal preferences. Indeed, Weinreich uses the word "preference" only once in the following context:

> "If the user fails to select the proper criteria for the search at step 1021, the routine will typically prompt the user to re-enter the correct search criteria. If, for example, the user intends to perform an occupation and geography search and only enters data representative of geographical ***preference***, then, step 1021A is executed notifying the user of the deficiency. If all of the proper search criteria are entered at step 1021, step 1022 is called."

See Col. 20, line 60- Col. 21, line 6 (Emphasis added). Thus, it is submitted that Weinreich does not anticipate or render obvious the instant rejected claims.

Weinreich is also not directed toward an analogous art. Weinreich requires each user to "know" another registered user. See Col. 3, lines 34-36 ("each user having a defined relationship to at least one other member of the database which is a confirmed relationship of one sort or another.") To accomplish this, Weinreich requires a "relationship type". See Col. 14, at lines 16-23), which states:

> "The user is then *required* to submit selected information. In the preferred embodiment, the information is input into four separate fields displayed on profile page 102: first name, last name, e-mail address, and *relationship type* (father, mother, employee, etc.) To initiate the process, the user is *required* to at least enter a last name, an e-mail address and a relationship type. Other information could be *required*."

(Emphasis added). In view of these points, all rejections based on Weinreich under § 102 and those where Weinreich is used as a primary reference under § 103 are believed overcome. Examiner is respectfully requested to review and reconsider.

Manolis does not anticipate independent claims of Ser. No. 13/089,775 PSCO-012

As an initial showing, an anticipating reference must not only contain all the elements of a rejected claim. "But it does not tell the whole story. Because the hallmark of anticipation is prior invention, the prior art reference – in order to anticipate under 35 U.S.C. §102 – must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements 'arranged as in the claim.' [Citation omitted.]" *Net MoneyIN, Inc. v. Verisign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008). In that case, the Court then explained the meaning of the phrase "arranged as in the claim" and stated that a claim that required several ingredients to be mixed in a specific order would not be anticipated by a prior art reference that disclosed all of the ingredients but not the order. "[A]n anticipatory reference [must] show all of the limitations of the claims arranged or combined in the same way as recited in the claims, not merely in a particular order. The test is thus more accurately understood to mean 'arranged or combined in the same way as in the claim.'" *Id.* at 1370. See also, *Lindemann Maschinenfabrik GnbH v. American Hoist & Derrick Co.*, 730 F.2d 1452 (Fed. Cir. 1984)(a claim to a shearing

machine was not anticipated by a prior art reference that contained all of the elements of the claimed machine "because it 'disclosed an entirely different device, composed of parts distinct from those of the claimed invention, and operating in a different way to process different material differently.'"); *Ecolochem, Inc. v. Southern California Edison Co.*, 227 F.3d 1361 (Fed. Cir. 2000) (holding that a method for deoxygenating water was not anticipated by a prior art reference that included a figure and text on the grounds that: "[T]here was no link between that figure and the general discussion of hydrazine as a deoxygenating agent. * * * although the reference taught all elements of the claim, it did not contain a discussion suggesting or linking hydrazine with the mixed bed in the figure, and thus did not show the invention arranged as in the claim.") It is "improper[] [to] combine[] parts of the two models of the prior art reference" to find anticipation. *Net MoneyIN*, at 1371. "The prior art reference must clearly and unequivocally disclose the claimed invention or direct those skilled in the art to the invention without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference.", *Id.*, (quoting *In re Arkley*, 455 F.2d 586 (CCPA 1972)).

"The requirement that the prior art elements themselves be 'arranged as in the claim' means that claims cannot be 'treated . . . as mere catalogs of separate parts, in disregard of the part-to-part relationships set forth in the claims and that give the claims their meaning.' Lindemann Maschinenfabrik GMBH v. Am. Hoist & Derrick Co., 730 F.2d 1452, 1459 (Fed. Cir. 1984). '[U]nless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.' *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008)." The Court stated:

> "Because the parties do not contend that the iKP reference discloses all of the limitations recited in claim 1 arranged or combined in the same way as in the claim, and because it was error for the district court to find anticipation by combining different parts of the separate protocols in the iKP reference simply because they were found within the four corners of the document, we reverse the district court's grant of summary judgment of invalidity."

Id. In addition, as argued above, the drag-and-drop feature as used in the rejected claims is not enabled in Manolis. Further, Manolis does not recite invoking an event handler function. Thus, Manolis cannot be an anticipating reference for the independent claims 2, 11 & 20. Reconsideration is respectfully requested.

Respectfully submitted,

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